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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,395	02/22/2005	Gunter Kaupp	KAUPPI	7134
1444 7590 09/25/2008 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			EXAMINER ABU ALI, SHUANGYI	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 09/25/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/525,395	<b>Applicant(s)</b> KAUPP ET AL.	
	<b>Examiner</b> SHUANGYI ABU ALI	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-2, 10-11, 13-20 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 10-11, 13-20 and 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-2, 10-11, 13-20 and 23-28 remain for examination.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

The rejection of claims 1-2, 10 and 16-20 under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5, 607, 504 to Schmid et al. alone or in view of the article entitled "Pigment for high performance" as generally set forth in the first office action mailed 07/11/2008 stands.

The rejection of claims 1-2, 10, 13-14, 17-18 and 25-26 under 35 U.S.C. 103(a) as being unpatentable over WO 00/09617 alone or in view of the article entitled "Pigment for high performance" as generally set forth in the first office action mailed 07/11/2008 stands. .

The rejection of claims 11, 15, 23-24 and 27-28 under 35 U.S.C. 103(a) as obvious over U. S. Patent No. 5, 607, 504 to Schmid et al., in view of U. S. Patent No.

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3389105 to Bolger et al. alone or in view of the article entitled "Pigment for high performance" .as generally set forth in the first office action mailed 07/11/2008 stands.

### ***Response to Arguments***

Applicant's arguments filed 07/11/2008 have been fully considered but they are not persuasive.

In general, applicants argue that all the primary references disclose multiple coatings (layers) of pigment. The Examiner respectfully submits that the instant application recites the transitional term "comprising", which is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. The prior art disclose that silica is the only layer coated on the substrate, thus reading on the claimed added limitation because this limitation does not exclude other layers that are coated on the preceding layers. Additional layers are coated on the silica layer and not the substrate.

Applicants argue that the references are silent about the properties of the pigment, such as resistance against sweat and saliva. The Examiner respectfully submits that the references teach the pigment with a layer of same material, such as silica, with an overlapping thickness coated on the substrate as applicant disclosed in the instant application, therefore, it would be expected that the pigment disclosed by the references has the same or similar properties absent any evidence to the contrary.

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Applicants argue that the silica amount in the pigment of the reference (Schmid et al) is much higher than that of the instant application. The Examiner respectfully submits that the amount of the silica in the pigment is in the range of the amount claimed by the instant application.

On page 13 of the response, applicants provide a table to show that Schmid et al. teaches away from the claimed ratio (instant claim 16) and this is not persuasive because (1) a reference can be used for all it realistically teaches and is not limited to only the examples and the reference clearly teaches the claimed ratio, as defined in the previous office action and (2) "teaching away" is a situation in which the reference states that something could not be done or is detrimental and the reference never makes this statement.

On page 15 of the response, applicants provide a table to show that Andes does not teach the claimed ratio (instant claim 16). The Examiner respectfully submits that claim 16 is not rejected under Andes et al. as regarding to the silica amount in the pigment.

Applicants argue that it is not clear why the citation of the reference "pigments for higher performance" was used. The Examiner respectfully submits that the above reference is used to show it would have been obvious to one of ordinary skill in the art at the time of invention by applicants to use metallic substrate with higher purity, as applicants disclosed in the instant application.

Applicants argues that Bolger disclosing a metal pigment coated with a layer of resin. The Examiner respectfully submits that Bolger is used to show that gold

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and bronze are widely used in metallic pigment. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Marcheschi/  
Primary Examiner, Art Unit 1793

sa